INTRODUCTORY REMARKS

In this Response, Applicant traverses the Examiner's rejections of all pending claims.

For the Examiner's convenience, a copy of all pending claims is provided herein.

REMARKS

In this Response, Applicant traverses the Examiner's rejections. Silence with regard to any of the Examiner's rejections should not be construed as acquiescence to any of the rejections. Specifically, silence with regard to any of the rejections of the dependent claims that depend from an independent claim considered by the Applicant to be allowable based on the Amendments and/or Remarks provided herein should not be construed as acquiescence to any of the rejections. Rather, silence should be construed as recognition by the Applicant that the previously lodged rejections are moot based on the Amendments and/or Remarks submitted by the Applicant relative to the independent claim from which the dependent claims depend. Applicant reserves the option to further prosecute the same or similar claims in the present or a subsequent application. Upon entry of the Amendment, claims 4, 6, 8, 14, 16-38, 40, 41, 43-45, 49, 55-57, 65-68, 71, and 78-93 are pending in the present application.

The issues of the March 5, 2004 Office Action are presented with respect to the Office Action:

<u>With respect to paragraphs 1-6:</u> Applicant thanks the Examiner for the consideration of the previously filed Response, for the withdrawal of the prior bases for rejection, and for the incorporation of the Examiner's amendment in correcting typographical errors.

<u>With respect to paragraphs 7-11:</u> The Examiner rejected the pending claims based on 35 U.S.C. 103(a) with reference to Appelt et al. (6,601,026) and Ellard (5,999,937). Applicant respectfully disagrees with the Examiner's interpretation of the prior art as it relates to Applicant's claims.

Appelt et al. teach a system that includes "an indexing facility configured to automatically generate indices of *dynamically updated* text sources *based on a pre-defined grammar.*" (emphasis provided by Applicant) See Col. 2, lines 21-22; Col. 2, lines 30-33; see also claim 1; see Abstract. The indexing facility, based on the *pre-defined grammar*, allows for a natural language interface to query the *dynamically updated text sources.* (e.g., Col. 2, lines 34-37)

In contrast to Appelt et al., Applicant's independent claim 14 is directed to a method for searching first and second data sources having *first and second data formats,* where the method includes *generating first and second customized queries* based on the first and second data formats of the first and second data sources. In the prior Response, Applicant stated that Appelt

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et al. do not teach generating first and second customized queries based on first and second data formats, and in the present Office Action, page 4, the Examiner agreed with the Applicant, stating "Appelt does not explicitly teach for the respective first and second data format and the respective first and second data sources." Accordingly, Applicant and the Examiner agree that Appelt et al. do not teach Applicant's claimed *generating first and second customized queries* based on the first and second data formats of the first and second data sources.

On page 5 of the Office Action, Examiner states that "Ellard discloses the first data format and the second data format are different data format," and that "therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Appelt with the teachings of Ellard..." Applicant respectfully disagrees with the Examiner's interpretation of Ellard and the criteria to sustain a prima facie case of obviousness.

As Examiner knows, a prima facie case of obviousness requires a suggestion or motivation to combine, a reasonable expectation of success, and a teaching or suggestion of all claim limitations. (MPEP §2143.) Applicant notes that Ellard teaches a "system and method for transferring data between an input data set and an output data set having possibly different formats..." (Abstract). In contrast to Appelt et al., Ellard is not a system for generating a query, for receiving a query, or even for responding to a query. Ellard is merely a system to convert an input to an output of different formats. As the Examiner knows, the teaching or suggestion to modify Appelt et al. in a manner suggested by Ellard must be found in the prior art; the teaching or suggestion to modify cannot be found in Applicant's disclosure. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references," In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "Teachings of references can be combined <u>only</u> if there is some suggestion or incentive to do so," (emphasis in original) In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988), quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

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PAGE 16/19 * RCVD AT 6/17/2004 9:46:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:617 832 7000 * DURATION (mm-ss):05-22

"Even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious," In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) "The examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references,'" In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

In the present Office Action, the Examiner provides no motivation to combine Ellard's system for converting an input to an output having different data formats, with Appelt et al.'s system for generating an index of *dynamically updated* text sources *based on a pre-defined grammar.*

Further, Applicant directs the Examiner to MPEP 2145.X.2, "References cannot be combined where reference teaches away from their combination." As provided herein, Appelt et al.'s system is based on *a pre-defined grammar* such that an index can be created for *dynamically updated* text sources. Appelt et al. specifically teach that the grammar on which the index is based is *pre-defined* such that changing content of the text documents are not affected by the query. It is thus Appelt et al.'s *pre-defined grammar* that insulates Appelt et al.'s system from using different formats, as such pre-defined grammar compensates for changes to the dynamically updated documents. It is therefore difficult to understand Examiner's proposition that one of ordinary skill in the art who learns of the teachings of Appelt et al.'s pre-defined grammar, would need or want, or be motivated, to accept a query and change it into different formats, as the Examiner suggests, when Appelt et al.'s *pre-defined grammar* already considers that the text documents may change. Applicant thus considers that the Examiner's proposed combination of Appelt et al. with Ellard is improper at least because Appelt et al.'s pre-defined grammar teaches away from a need for a different format. There is thus also a lack of reasonable expectation of success in the proposed combination of Appelt et al. with Ellard, as it is unclear how Appelt et al.'s pre-defined grammar could be reconciled with differing query formats.

The Examiner thus fails to provide a prima facie case of obviousness for failing to provide any motivation to combine Appelt et al. with Ellard, and as provided herein, Appelt et

al.'s pre-defined grammar teaches away from such combination. Accordingly, there is also no reasonable expectation of success in the proposed combination. Additionally, as Examiner stated, Appelt et al. do not teach Applicant's claimed *generating first and second customized queries* based on the first and second data formats of the first and second data sources, and further, Ellard merely teaches converting an input to different format outputs, which also does not teach Applicant's claimed *generating first and second customized queries* based on the first and second data formats of the first and second data sources. Because neither reference teaches Applicant's claimed feature, Examiner fails to show that the proposed combination includes all features of Applicant's independent claim 14.
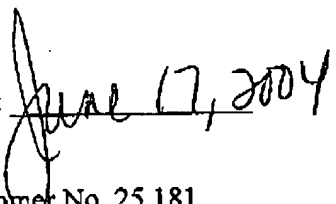
Because the Examiner fails to show any of the elements of a prima facie case of obviousness, Applicant traverses the Examiner's 35 U.S.C. 103(a) rejection of independent claim 14, and considers independent claim 14 to be allowable. Because claims 4, 6, 8, 16-38, 40, 41, 43-45, and 78-80 depend from allowable independent claim 14, Applicant thus traverses the Examiner's rejection of these dependent claims and considers claims 4, 6, 8, 16-38, 40, 41, 43-45, and 78-80 to be allowable as depending on an allowable base claim.

Independent claims 55 and 65 include features similar to allowable independent claim 14, and hence, for the same reasons provided herein relative to allowable independent claim 15, Applicant traverses the Examiner's 103(a) rejection of independent claims 55 and 65, and considers independent claims 55 and 65 to be allowable. Because all other pending claims depend from one of allowable independent claims 55 and 65, Applicant also traverses the Examiner's rejection of such dependent claims, and considers such claims to be allowable for depending from an allowable base claim.
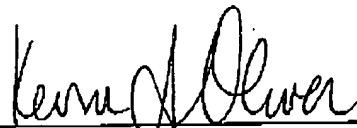
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CONCLUSION

Applicant considers this Response to be fully responsive to the present Office Action. Based on the foregoing Remarks, Applicant respectfully submits that this application is in condition for allowance. Accordingly, Applicant requests allowance. Applicant invites the Examiner to contact the Applicant's Attorney if any issues are deemed to remain prior to allowance.

Respectfully submitted,
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